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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/693,052

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Yi-Chung Chan

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EXAMINER

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/693,052	<b>Applicant(s)</b> CHAN, YI-CHUNG	
	<b>Examiner</b> LaTanya Bibbins	<b>Art Unit</b> 2627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 29-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 29-38 is/are allowed.
- 6) ☒ Claim(s) 39-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

**1.** In the remarks filed on April 20, 2009, Applicant amended claims 29-31, 39-42 and 44-46 and submitted arguments for allowability of pending claims 29-48.

### ***Response to Arguments***

**2.** Applicant's arguments, filed April 20, 2009, with respect to claims 29-38 have been fully considered and are persuasive. The rejections of claims 29-38 have been withdrawn.

**3.** Applicant's arguments, filed April 20, 2009, with respect to claims 39-45 have been fully considered. Given Applicants removal of the term "controller" from claims 39-45 the 35 U.S.C. 112 first paragraph rejection of claims 39-45 with regard to the "controller" has been withdrawn. However, upon further consideration of the newly amended claims, a new 35 U.S.C. 112 first paragraph rejection is made (see the rejection below).

**4.** Applicant's arguments filed April 20, 2009, with respect to claims 46-48 have been fully considered but they are not persuasive.

**Regarding claims 46-48,** Applicant argues that the claimed "processor-readable medium" is supported by paragraphs [0005] and [0006] of the published disclosure and further that one skilled in the art would recognize that the optical device and optical disk system of paragraphs [0005] and [0006] would include a medium capable of storing instructions as claimed.

Examiner respectfully disagrees. Paragraphs [0005] and [0006] of the publication provide discussion of the related art and problems with the related art. There is no disclosure of a processor-readable medium or a processor-readable medium which stores instructions for discriminating a type of an optical storage medium, implied or inherently, in the referenced paragraphs or any other paragraphs in Applicants specification. As such, Examiner maintains that the specification fails to provide proper antecedent basis for the claimed subject matter and that claims 46-48 added September 15, 2008 is not supported by the as-filed disclosure and violates the written description requirement.

### ***Drawings***

**5.** The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the apparatus for discriminating a type of an optical storage medium and a processor-readable medium must be shown or the features canceled from the claims. **No new matter should be entered.**

Not only does the specification fail to contain a written description of the subject matter now recited in claims 39-48, but also none of the drawings show or describe the subject matter or features of claims 39-48.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate

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prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

6. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). There should be clear support or antecedent basis in the specification for the terminology used in the claims. Applicant employs the term “processor-readable medium” in claims 46-48. The terms do not appear in the specification. Correction is required.

### ***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

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art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**8. Claims 39-48 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.**

The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. New or amended claims which introduce elements or limitations which are not supported by the as-filed disclosure violate the written description requirement, i.e., are new matter. See MPEP § 2163 I(B).

**Regarding claims 39-45**, the original specification fails to disclose or describe the subject matter now claimed in claims 39-45. Nowhere in the original specification can be found a written description of an apparatus comprising an optical disk system configured/implemented to perform all of the functions as now specifically recited in apparatus claims 39-45.

**Regarding claims 46-48**, the original specification fails to disclose or contain a written description of a processor-readable medium that is for storing/implementing instructions for discriminating a type of an optical storage medium as now recited in claims 46-48.

***Claim Rejections - 35 USC § 112***

**9.** The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**10. Claims 39-45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

**Claims 39-45** recite an optical disk system configured to measure a distance between a reflection layer of the optical storage medium and a surface layer of the optical storage medium however, there are no structures provided/recited to constitute such optical disk system in order to perform the claimed functions. Accordingly, it is unclear how the optical disk system alone can perform all of the functional limitations recited in claims 39-45. The functional limitations recited in claims 39-45 are apparently directed to an explanation or intended result of the optical disk system since no structures or sources are provided in the optical disk system to perform such functions.

***Allowable Subject Matter***

**11. Claims 29-38** are allowed.

**12.** The following is an examiner's statement of reasons for allowance:

**Regarding claims 29-38**, none of the references of record, alone or in combination, suggest or fairly teach the limitations of independent claim 29 in such a manner that a rejection under 35 U.S.C. 102 or 103 would be proper. Although the prior art discloses a method for discriminating a type of an optical storage medium, comprising: employing at least an optical pickup to measure distance between a reflection layer of the optical storage medium and a surface layer of the optical storage

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medium; the prior art fails to disclose **determining a distance error of the measured distance between the reflection layer of the optical storage medium and the surface layer of the optical storage medium; if the distance error is less than a failure threshold, comparing the measured distance with a distance threshold to discriminate a type of the optical storage medium; and if the distance error is greater than or equal to the failure threshold, employing an alternate method to discriminate the type of the optical storage medium.**

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

**9. Regarding claims 39-48,** search has been performed for limitations recited in these claims, but no statement will be made in this Office Action regarding the allowability over the prior art due to the 35 USC. 112 first and second paragraph rejections noted above. Examiner will refrain from making a prior art rejection until the intended patentable coverage of the invention is made clear by Applicant.

### ***Conclusion***

**13.** Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).



A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LaTanya Bibbins whose telephone number is (571)270-1125. The examiner can normally be reached on Monday through Friday 7:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wayne Young can be reached on 571 272-7582. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/LaTanya Bibbins/  
Examiner, Art Unit 2627

/Thang V. Tran/  
Primary Examiner, Art Unit 2627